REMARKS

This amendment is in response to the Non-Final Office Action dated June 27, 2008 (Office Action). In the amendment, claims 1 and 4 – 10 have been amended, and claims 2 and 3 have been canceled.

Regarding Claim 1 and 6 – 10, Applicant has corrected some minor grammatical errors and, specifically in claim 6, 7, and 10, inserted an 'or' to eliminate vagueness by appropriately representing the three possible combinations: horizontal placement and tilting placement, horizontal placement, and tilting placement.

Reconsideration and allowance of the pending claims 1 and 4 – 10 is requested in view of the following remarks. *No new matter has been added by these amendments.*

Claims 1 – 10 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicant submits that the noted claims recite patentable subject matter. Nevertheless, to expedite prosecution, Applicant has amended claims 1-10 without prejudice. These amended claims are very clearly drafted in acceptable "Beauregard" form. The acceptability of these types of claims was recently confirmed by the Board of Patent Appeals and Interferences in the decision *Ex parte* BO LI, Appeal 2008-1213, regarding App. Ser. No. 10/463,287 (decided November 8, 2008).

As confirmed in that decision, a computer program product claim as such is an acceptable product claim. Applicant's claims recite a computer program product stored on a computer readable medium and adapted to perform the recited operations. This constitutes statutory subject matter as clearly indicated by the BPAI (and Federal Circuit).

Moreover, to the extent that there may be recent narrowing of the view of patentable subject matter in the wake of the ostensibly expanded view of the same in *State Street* and its progeny, it is clear that all of Applicant's claims are clearly within the bounds of what is considered statutory, and not in a suspect area. That is, the claims recite patentable methods and products, rather than "pure mental steps" or illusory, transitory signals in the abstract. (*See*, for example, *In re Comiskey*, 499 F.3d 1365, 84 U.S.P.Q.2d 1670 (Fed. Cir. 2007) (mental process of resolving a legal dispute between two parties by the decision of a

human arbitrator considered non-statutory subject matter); *See also In Re Nuijten*, 515 F.3d 1361, 85 U.S.P.Q.2d 1927 (Fed. Cir. 2008) (transitory, propagating signal (not modulated onto carrier signal) considered non-statutory subject matter)).

Claim 2 has been rejected under 35 U.S.C. § 102(b) as being anticipated by *Kobari et al.*, Japanese Publication No. 8-167039 *(Kobari)*. This rejection is believed to be moot in light of the above amendment, and Applicant thus respectfully requests that these grounds of rejection be withdrawn.

Claim 3 has been rejected under 35 U.S.C. § 102(e) as being anticipated by *Freeman et al.*, U.S. Patent No. 5,724,072 *(Freeman)*. This rejection is believed to be moot in light of the above amendment, and Applicant thus respectfully requests that these grounds of rejection be withdrawn.

Claims 1 and 4 have been rejected under 35 U.S.C. § 103(a) over *Kobari* in view of *Fushiki et al.*, U.S. Patent No. 6,868,524 *(Fushiki)*. These rejections are respectfully traversed.

Independent claim 1 recites "*performing a horizontal placement to place a character string along a prospective guide line that is located at the center of prospective guide lines that are longer than the longest horizontal segment of the area of the character string, the prospective guide lines being drawn as virtual horizontal lines at regular intervals in the demarcated region.*" *Kobari* does not disclose these features.

Specifically, the Office Action suggests that paragraphs [0015] – [0018] of *Kobari* "disclose selecting the longest lines." For convenience these paragraphs are provided below:

"[0015]

Next, as shown in drawing 3, inclination of a character string is determined about each polygon. As for 4, in drawing 3, a polygon circumscribed quadrangle and 6 are character string existence quadrangles a polygon and 5. Determination of inclination is performed as follows.

[0016]

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(4) When the following conditions are fulfilled, incline horizontally.

[0017]

(4a) The actual breadth of the character string circumscribed quadrangle 6 in the middle point of the lengthwise direction of the circumscribed quadrangle 5 of a polygon should have more than a "character string width + threshold."

[0018]

(4b) the middle point of the circumscribed quadrangle 6 of a character string -- the intersection of the middle point of the lengthwise direction of the circumscribed quadrangle 5 of a polygon, and the middle point of the actual breadth of the character string circumscribed quadrangle 6 -- inclination -- when it is level and you have arranged, full inclusion should be carried out at the polygon 4."

Paragraph [0015] describes and labels three polygons. Paragraph [0016] states the purpose of these four paragraphs. Paragraph [0017] details the minimum space required for inclining. Paragraph [0018] aligns the midpoints of polygon 5 and 6; provides an inclination; and then includes this change into polygon 4. There is no actual selecting of any lines or segments in the cited section, and "selecting the longest lines" is not part of the Applicant's independent claim 1 language. Clearly, none of the features in independent claim 1 are disclosed.

Also, the Office Action admits that *Kobari* does not disclose "*a prospective guide line*;" therefore, *Fushiki* is apparently relied upon to disclose "producing scan lines to determine string placement."

Fushiki's scan lines (e.g., 302-306) in Fig. 4 are at intervals, equal to the text height, resulting in rectangles (e.g., 308) to write text directly in. Applicant's claimed invention "*place*[*es*] *the character string along a prospective guide line*," which is located at the center of total set of prospective guide lines. Placement along the "*prospective guide line*,"

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as described in the specification, is the matching of the center point of the *"prospective guide line"* with the center point (or the gravity point) of the character string. (See [0043]).

Therefore, Applicant does not need to make rectangles nor require the intervals to equal the text height. Also, the *"prospective guide line"* is a *"virtual horizontal line,"* and drawing *"prospective guide lines"* at predetermined intervals is an imaginary act that, in reality, describes the distances calculated within the *"demarcated region."*

This clearly is divergent from the Applicant's claimed invention and offers nothing to remedy the deficiencies of *Kobari*.

Even if the Office Action's presumptions were true and *Kobari* proposed selecting the longest of the lines that define a polygon while *Fushiki* proposed using scan lines in a region, this combination's teaching would be the limited result of a *Kobari* polygon (e.g., polygon 4) full of *Fushiki* scan lines (e.g., scan lines 302-306). There would be no teaching or suggestion for **1) selecting the center of prospective guidelines that are longer then the horizontal segment of the area of the character string and 2) placing the character string along the prospective guide line that is located at the above-mentioned center of the prospective guidelines,** as recited in claim 1.

In addition, the proposed combination of references and the underlying analysis is also faulty. "A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements [were], independently, known in the prior art." (*KSR International Co. v. Teleflex inc.*, 127 U.S. 1727, 1741, 82 USPQ2d 1385, 1397 (2007); *See also KSR*, 127 U.S. at 1739-1742, 83 USPQ2d at 1395-1396 (analyzing and summarizing *United States v. Adams*, 383 U.S. 39, 128 USPQ 479 (1966), *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 395 U.S. 7, 163 USPQ 673 ()1969), and *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 189 USPQ 499 (1796))).

The Office Action appears to state that because of the independent features in the references the Applicant's invention as a whole is disclosed. This unsupported conclusion does not set forth the required findings and analysis for obviousness set forth in *KSR*. Applicant's present invention teaches selecting the center of prospective guidelines that are longer that the longest horizontal segment of the area of the character string and placing the

character string along the prospective guide line that is located at the above-mentioned center of the prospective guidelines. Despite the Office Action's apparent statements, these two steps are not found in the prior art nor are they suggested.

Furthermore, "the [*Graham*] factors continue to define the inquiry that controls [obviousness]." (*KSR*, 127 U.S. at 1734, 82 USPQ2d at 1391; *See Graham et al. v. John Deere Company et. al.*, 383 U.S. 1, 148 USPQ 459; *See also Examination Guidelines for Determining Obviousness*, MPEP § 2141.II.C ¶¶ 1).

The Office Action attempts to summarize the *Graham* factors required under *KSR* on page 4 of the Office Action, yet the Office Action fails to associate any reasoning or conclusions under those factors.

Specifically, the Office Action fails to detail "the level of ordinary skill." (*Id.*). In omitting this factor, the Action does not set forth the required findings and analysis for obviousness set forth in *KSR*.

By stating that the combinations of prior art are obvious simply because the prior art exists and omitting the level of ordinary skill in which obviousness is found, the Office Action makes a conclusory statement with no explicit reasoning. (*See KSR*, 127 U.S. at 1341, 82 USPQ2d at 1396 citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")).

Regardless, since the relied-upon references do not individually or in combination disclose the claimed features of the Applicant's invention, and since the Office Action fails to properly detail the factors of obviousness, a *prima facie* case of obviousness has not been established.

For similar reasons, dependent claim 4 is also distinct from the relied upon references since it incorporates the features of independent claim 1 and for its separately recited patentably distinct features.

Specifically, dependent claim 4 recites "*wherein the computer is caused to perform adjusting placement to move the placed character string vertically or horizontally*

within the demarcated region." Kobari's citation (*Kobari*, [0026]) does not disclose movement of a character string in the horizontal direction. In fact, movement of the character string in Kobari requires a vertical bisectrix in which the character string slides.

Applicant's claimed invention uses the character string's center (or gravity point) when moving the character string in any direction, preferably in the direction where the maximum space is available between the center point of the *"prospective guide line"* and a demarcated region segment. (See [0046]).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1 and 4 under 35 U.S.C. § 103(a) as being unpatentable over *Kobari* in view of *Fushiki*.

Claim 5 has been rejected under 35 U.S.C. § 103(a) over *Kobari* in view of *Fushiki* in further view of *Freeman.* This rejection is respectfully traversed.

For similar reasons as above, dependent claim 5 is distinct from the relied upon references since it incorporates the features of independent claim 1 and for its separately recited patentably distinct features.

The Office Action admits that *Kobari* and *Fushiki* do not "disclose placing the label in the center;" therefore, *Freeman* is apparently relied upon to disclose "placing the label into the geographic center."

Dependent claim 5 recites *"wherein the computer is caused to perform centering placement to arrange the placed character string in such a manner that the distances between the demarcated region segments that demarcate the demarcated region and dots on character string region segments that demarcate the character string region are made uniform."*

The distinction between *Freedman* and Applicant's claim 5 begins with *Freedman* using a local placement search array (e.g., LPS array) within a window (e.g., window 140) to determine the center of said window. In this method, individual pixel values determine the window's center by placing the window over a region (e.g., region 143).

Applicant's claimed invention performs a *"centering placement . . . in such a manner that the distances between the **demarcated region segments** . . . [and] the character string . . . are made uniform."* Applicant's claimed invention does not superimposed a

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window over a demarcated region, nor does Applicant's claimed invention use pixel values to compute a recommended center.

Clearly *Freedman* is divergent from the Applicant's claimed invention and offers nothing to remedy the deficiencies of *Kobari* and *Fushiki*.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Kobari* in view of *Fushiki* in further view of *Freeman*.

Claims 6, 7, and 10 have been rejected under 35 U.S.C. § 103(a) over *Kobari* in view of *Fushiki* in further view of *Freeman.* This rejection is respectfully traversed.

For similar reasons as discussed above, independent claim 6 is distinct from the relied upon references for its separately recited patentably distinct features. Specifically, independent claim 6 recites *"performing a first horizontal placement or a first tilting placement on all demarcated regions;*

performing a pull-out placement on each demarcated region in which the first horizontal placement or the first tilting placement cannot be performed, assuming that the character string placed in the first horizontal placement or the first tilting placement has not been placed;

performing a second horizontal placement or a second tilting placement to place the character string placed in the first horizontal placement or the first tilting placement, and, when the placement cannot be performed because of the character string placed through the pull-out placement, nullifying the character string placed through the pull-out placement hindering the placement, thereby placing the character string through the second horizontal placement or the second tilting placement."

The Office Action suggests that *Kobari* and *Fushiki* "disclose the inclination of the line if it does not fit" and cites *Kobari* [0015] – [0026] for support. The reference citation, which is partially reproduced above, details an inclination method that uses the intersection of the two bisectrices of a polygon (e.g., polygon 4) to arrange the character string between the middle point of the longest neighborhood of the polygon and the first intersection.

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Contrarily, Applicant's claimed invention provides *"performing . . . [a] titling,"* which is when the character string is tilted along the longest demarcated region segments that demarcate the demarcated region. Cleary, adding an imaginary quadrangle (e.g., *Kobari* quadrangle 5) to generate intersections with a bisected polygon is a different feature then Applicant's *"titling."* Also, 'inclination of the line if it does not fit' is not part of the Applicant's independent claim 6 language.

The Office Action admits that that *Kobari* and *Fushiki* "do not disclose pop out placement;" therefore, *Freedman* is apparently relied upon to "disclose the pop out placement." However, *Freedman* requires "(a) creating an enlarged placement window centered about the recommended label position extending outside the primary placement window and encompassing at least a part of one region bordering the primary region."

Contrarily, Applicant's claimed invention provides *"performing the pull-out placement"* by placing a character string that shares the longest demarcated region segment with the subject demarcated region. (See [0054]). Clearly, creating another placement window is not part of Applicant's design because Applicant uses available space in neighboring demarcated regions.

For similar reasons as each above discussion, dependent claims 7 and 10 are also distinct from the relied upon references since they incorporate the features of independent claim 6 and for their separately recited patentably distinct features.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 6, 7, and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Kobari* in view of *Fushiki* in further view of *Freeman.*

Claims 8 and 9 have been rejected under 35 U.S.C. § 103(a) over *Kobari* in view of *Fushiki* in further view of *Freeman* in further view of *Yoshimura et al.*, Japanese Publication No. 9-185696 (*Yoshimura*). This rejection is respectfully traversed.

For similar reasons as discussed above, dependent claim 8 is distinct from the relied upon references since it incorporates the features of independent claim 6 and for its separately recited patentably distinct features.

The Office Action admits that that *Kobari*, *Fushiki*, and *Freedman* "do not disclose replacement placement;" therefore, *Yoshimura* is apparently relied upon to "replacement placement." For convenience the Office Action's citation, *Yoshimura* [0118], is provided below:

> "[0118]
>
> (c) Use a character code and a registration dictionary as input data in string conversion processing string conversion processing. In this processing, it is judged whether the character string applicable to the keyword of a registration dictionary is contained in a character code. If there is a character string contained, the applicable character string part of a character code will be changed into the abbreviation of a registration dictionary, and the character code after conversion will be outputted."

Dependent claim8 recites "*wherein the operations function comprises: a replacing placement, after the second horizontal placement or the second tilting placement, to place alternative display objects such as characters, other character strings, symbols, or graphics, instead of the character string that cannot be placed in the first horizontal placement or the first tilting placement, the pull-out placement, or second horizontal placement or the second tilting placement.*"

Yoshimura uses a character code and registration dictionary to abbreviate applicable character strings, which is contrary to "*plac[ing] alternative display objects such as characters, other character strings, symbols, or graphics, instead of the character string that cannot be placed in the first horizontal placement or the first tilting placement, the pull-out placement, or second horizontal placement or the second tilting placement.*"

Also for similar reasons as discussed above, dependent claim 9 is distinct from the relied upon references since it incorporates the features of independent claim 6 through its incorporation of dependent claim 8 and for its separately recited patentably distinct features.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over *Kobari* in view of *Fushiki* in further view of *Freeman* in further view of *Yoshimura*.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. HIR-0037 from which the undersigned is authorized to draw.

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Respectfully submitted,

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